

Appl. No. 09/914,244
Amdt. dated July 16, 2004
Reply to Office Action of May 6, 2004

REMARKS/ARGUMENTS

Applicants appreciate Examiner's acknowledgment of allowable subject matter in claims 3, 6-9.

Claims 1 – 9 remain pending in the application.

Claims 4, 8, and 9 have been amended per Examiner's suggestions.

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. §102(e) as being anticipated by US Patent No. 6,381,082, hereinafter, "*Voorman*."

Applicants respectfully traverse the Office Action's assertion. Applicants have fully read *Voorman*, the feature of "which method includes a data signal compression step which is triggered off when a thermal roughness is detected," is not cited. Applicants note the Office Action's citation of "non-linear transconductance amplifier 14 is provided. . . (*Voorman*, col. 3, lines 7-12)." Further, Applicants note the citation of FIG. 4 and accompanying text, ". . . Clearly visible is that the wanted signal which is the sinusoid superimposed on the asperity signal remains visible through the asperity, which the peak value of the signal is reduced. (*Voorman*, col. 3 lines 66-67 – col. 4, lines 1-2)". However, *Voorman* presents no discussion of "data signal compression" as it relates to Applicants' claimed features in their invention.

Contrary to the Examiner's statement that all elements are disclosed in *Voorman*, the element of "data signal compression" is unsupported and should be withdrawn. Per MPEP §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Consequently, a case for §102(e) rejection has not been made.

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Applicants believe they have addressed the Examiner's concerns. Therefore, claims 1 – 9 are allowable over the cited reference. A timely Notice of Allowance is respectfully requested.

Please charge any fees other than the issue fee and credit any overpayments to Deposit Account 14-1270.

Respectfully submitted,

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